

REMARKS

Claims 1-20 are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested. The Examiner's comments are appreciated.

Application Status

Claims 13 and 17 were indicated allowable if rewritten in an independent format. Claims 13 and 17 have been rewritten in an independent format. Applicants respectfully submit that these claims are now allowable.

The Office noted a typographical error at specification page 32, line 2. This typographical error has been corrected.

The drawings were objected to under 37 C.F.R. § 1.83(a).

Claims 1 and 4 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claim 16 was rejected under 35 U.S.C. § 102(b) over Furuki (US 6,000,689).

Claims 1-3, 9-10, 14-15, and 20 were rejected under 35 U.S.C. § 103(a) over Furuki.

Claims 4-7, 11-12, and 18-19 were rejected under 35 U.S.C. § 103(a) over Furuki in view of Westcott (US 5,921,539).

Claim 8 was rejected under 35 U.S.C. § 102(b) over Furuki in view of Westcott and Geib.

Objection to the Drawings

Applicants respectfully traverse the drawing objection. Applicants respectfully submit that the drawing objection is contrary to USPTO practice. The application includes at least one process claim. It is USPTO practice that a drawing is not necessary for an understanding of the

invention, nor is a drawing even required when an application includes at least one process claim. Note MPEP § 601.01(f) and MPEP § 608.02. Applicants reserve the right to delete all of the (not required) drawing figures and references thereto. On this basis it is respectfully submitted that the drawing objection should be withdrawn.

Amendment to the Drawings

Nevertheless, as a courtesy to the Office, Figure 18A has been added to provide a different angle of detail already shown in Figure 18. A Request to Amend Drawings is attached herewith.

Figure 18A shows a side view taken in a direction parallel to the axis of the shaft (254) and toward the carry away roll (252). Figure 18A shows that the spring portion (245) acts on the shaft (254) to bias the carry away roll (252) to engage the middle disk portion (218).

Although the operational arrangement of the spring portion (245) is shown in Figure 18A, the spring portion (243) operates in a similar manner, in accordance with Figure 18. That is, the spring portion (243) can act to engage the shaft portion (248) and/or the fastening clip portion (241) of guide member (250) to bias the stripping member (246) toward middle disk portion (218). A portion of the guide member (250) is also shown in Figure 20. As explained in the specification, the upper surface of the guide member (250) has a contour that facilitates the directing of notes into the nip area where the stripping member (246) engages the middle disk portion (218).

Reference to Figure 18A has been accordingly added to the specification. Applicants again respectfully request that the drawing objection be withdrawn.

The 35 U.S.C. § 112, Second Paragraph, Rejections

Claims 1 and 4 were rejected as indefinite. Applicants respectfully traverse the rejections.

Claim 1

Claim 1 recites “deforming a first leaf spring portion . . ., releasing force holding a stripping member adjacent a rotatable sheet picking member”. The specification explains that “Leaf spring portion 243 biases shaft 248 and stripping member 246 toward middle disk portion 218” (at page 32) and “a servicer may manually *deform* leaf spring portion 243 so as to move the free end of the leaf spring downward such that it *no longer holds* the stripping member 246 in adjacent relation of the picking member” (at page 38). That is, the leaf spring (243) can be deformed to move downward (such that the free end thereof is disposed below the shaft (248)) enabling the stripper member (246) to be released from the biasing force of the leaf spring (243). Thus, in an exemplary embodiment, deforming the leaf spring can release force holding the stripping member adjacent the picking member. It follows that claim 1 is not indefinite.

Claim 4

Claim 4 recites “moving a resilient tab portion integrally formed with the housing, releasing a force holding the picking member in engagement with a drive shaft”.

As discussed in an exemplary embodiment (e.g., specification pages 28-29), the picking member (212) can include each of the shaft portion (214), the middle disk portion (218), and the outboard disk portions (220, 222). Thus, the picking member (212) includes a picking member shaft portion (214). Furthermore (e.g., specification pages 35-36), a tab portion (270) includes a bushing (272) that is adapted to accept therein one end of the picking member shaft portion

(214). The other end of the picking member shaft portion (214) is releasibly engageable with a drive shaft (274). It appears that the Office confuses the shaft portion (214) for the drive shaft (274), and the middle disk portion (218) for the picking member (212). Applicants respectfully submit that claim 4 is not indefinite.

The 35 U.S.C. § 102(b) Rejection

Claim 16 was rejected under 35 U.S.C. § 102(b) over Furuki. Applicants respectfully submit that Furuki does not anticipate claim 16.

Claim 16

The Office alleges that Furuki teaches an integral spring (11), a stripping member (4), and a picking member (3). However, where does Furuki teach that the spring (11) is a leaf spring? Even the Office admits that Furuki “does not teach of using a leaf spring” (Action page 6, line 7).

Additionally, where does Furuki teach that the spring (11) is “integrally formed on a housing within an automated banking machine”? Even the Office admits that Furuki does not teach a “spring integrated into the housing” (Action page 6, lines 7-8).

Further, where does Furuki teach moving a stripping member away from a picking member axis *subsequent* to the alleged deforming of the spring (11)? The alleged stripping member (4) in Furuki appears to move together with the spring (11) *during* movement of the spring (11). Thus, the alleged stripping member (4) would be moved with the spring (11), not subsequent thereto.

For brevity the Applicants have not necessarily presented all of the reasons as to why

Furuki does not anticipate the claim. Nevertheless, Applicants' remarks are sufficient to show that Furuki does not teach every feature, relationship, and step arranged in the manner recited in the claim, as is required to sustain the rejection. Applicants reserve the right to later present even more reasons negating the allegation of anticipation.

The 35 U.S.C. § 103(a) Rejections

Claims 1-3, 9-10, 14-15, and 20 were rejected under 35 U.S.C. § 103(a) over Furuki.

Applicants respectfully traverse the rejections.

Claim 1

For reasons of brevity, Applicants' previous remarks regarding the patentability of claim 16 are incorporated herein by reference. For reasons already discussed, Furuki neither teaches nor suggests the recited method. For example, as previously discussed, where does Furuki teach or suggest a leaf spring; a spring integrally formed on a housing; and movement of the alleged stripping member (4) subsequent to the alleged deforming of the spring (11)?

Furthermore, in addition to Applicants' incorporated remarks, where does Furuki teach or suggest a "cash dispensing automated banking machine"?

Nor would it have been obvious to one having ordinary skill in the art to have used a leaf spring instead of Furuki's disclosed spring (11), as alleged. Even if it were somehow possible (which it is not) for Furuki to have used a leaf spring as alleged, the Action is silent as to how Furuki could have been structurally modified to have provided a "housing" on which the leaf spring would be integrally formed.

The only suggestion for a leaf spring (and the other recited features) is found in

Applicants' own novel disclosure. It follows that the rejection is based solely on hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The only relied upon reference (Furuki) does not teach or suggest the recited method of claim 1. The Office even acknowledges that Furuki does not teach or suggest every feature, relationship, and step in the claim. The Office has not presented any other evidence (from Furuki) that teaches or suggests the recited features. It follows that the Action's assertion of obviousness is not based on any evidence in the record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). It further follows that the Office has not established a *prima facie* case of obviousness.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. Thus, it is asserted that the dependent claims are allowable on at least the same basis. Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. The reference(s) do not teach or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Fee For Extra Independent Claim

Four (4) independent claims are pending. Please charge the fee associated with the submission of one additional independent claim (\$200) and any other fee due to Deposit Account 09-0428.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000